

Appl. No: 09/858,043

Reply to Office Action of September 8, 2005

## REMARKS

This Response is submitted in reply to the Office Action dated September 8, 2005. Claims 1-5 are pending in the patent application. Claims 1, 3, and 5 have been amended. No new matter has been introduced with these amendments.

In the Office Action, Claims 1 and 3, as amended in Applicants' Response to Office Action dated July 12, 2005, are rejected under 35 U.S.C. § 112, as failing to comply with the enablement requirement. Specifically, the Examiner states that the specification does not provide support for the claim term "wherein the non-skip area cannot be designated by the user" and that the specification does not indicate a "specific entity specifically responsible for designation of non-skip area data." Applicants respectfully disagree with and traverse this rejection because the specification sufficiently describes and enables one of ordinary skill in the art to practice the invention.

First, one of ordinary skill in the art would recognize that the specification discloses that the user cannot designate the non-skip area. The specification provides that the content managing company "totally manages" the content file, such as content data of moving pictures including movies and dramas, content data of still pictures, content data of music programs and so forth. *See, Specification*, page 4, lines 7-8. The content managing company manages the content library which stores the various content that the content managing company provides and sells. *Id.*, page 4, lines 11-15. This content library, managed by the content managing company, stores the information designated as a non-skip area. *Id.*, page 13, lines 6-7. Additionally, the content library includes a content creator information database which "stores information associated with the non-skip areas of the content files for each content information provider," such as the "delivery file" to be delivered to the user should they skip the non-skip portion of the content file. *Id.*, page 13, lines 12-17. Nowhere does the specification suggest that the user manages the content library and designates the non-skip area. Rather, a person having ordinary skill in the art would recognize from the specification that the content managing company, information provider, or other non-user party designates the non-skip area.

Tellingly, the very problem that the present application overcomes is the situation where the user determines which portions of the content file that he or she wishes to skip. The background section of the present application states that information providers suffer from a user

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having the ability to selectively skip important messages or commercials using forward and backward skipping operations of the user terminal unit. See, *Specification*, page 2, lines 3-8. The summary of the present application provides that "even if the important information is skipped by the user at the user terminal unit, the information can be securely delivered to the user by other channels." *Id.*, page 3, lines 6-8. Thus, one advantage of the present application is that it addresses the ability of the user to selectively skip important messages. This is also supported in the specification at page 12, line 20, through page 13, line 5 ("[t]hus, the information provider is ensured that the important information has been securely delivered to the user."). Enablement is determined from the viewpoint of a skilled artisan using the knowledge and skill with which such a person is charged. See e.g., *Northern Telecom Inc. v. Datapoint Corp.*, 908 F.2d 931, 15 USPQ2d 1321, 1329 (Fed. Cir. 1990). If the user were able to designate the non-skip area, effectively choosing which portions of the content file he or she wished to view or listen to, one of the advantages of the present application would be thwarted and the information providers would not be "ensured that the important information has been securely delivered to the user." Thus, a person having ordinary skill in the art would recognize that the claim language "wherein the non-skip area cannot be designated by the user" is supported by the specification. Applicants respectfully submit that the specification enables the claim term "wherein the non-skip area cannot be designated by the user," thus, this rejection should be withdrawn.

In the Office Action, Claims 1-5 are rejected under 35 U.S.C. § 103(a). With respect to the obviousness rejection of Claims 1-5, the Examiner relies on U.S. Patent No. 6,219,694 to Lizaridis ("*Lizaridis*"). Of these Claims, Claims 1 and 3 are the sole independent claims. As discussed above, Claims 1 and 3 have been amended in Applicants' Response to Office Action dated July 12, 2005, to include clarifying language, which was not considered by the Examiner in the Office Action. As discussed above, this clarifying language is fully supported in the specification and should be considered. Thus, Applicants believe that the rejections have been overcome in view of the clarifying language and for at least the reasons below respectfully request that the obviousness rejections be withdrawn.

Applicants believe that Claims 1-5 are nonobvious with respect to the *Lizaridis* reference for at least a number of reasons. First, *Lizaridis* and the claimed invention differ with respect to how the *Lizaridis* patent and the claimed invention handle the creation of triggering events.

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Independent Claims 1 and 3 recite a content delivering method for transmitting information corresponding to a non-skip area once the non-skip area has been skipped. The method includes, in part, designating a non-skip area of a content file, *where the non-skip area cannot be designated by a user*. The "event" that triggers the transmission of the information corresponding to the non-skip area is the skipping of the non-skip area. As indicated above, in Claims 1 and 3, the user does not designate the non-skip area of the content file - thus the user does not *define* the event trigger at all. This is in direct contrast to the user defined "triggers" in *Lazaridis*. *Lazaridis* provides for a system and method of event-driven redirection which, upon sensing a particular *user-defined event* has occurred, redirects user-selected data items from the host system to the user's device. See e.g., *Lazaridis*, column 2, lines 48-53. Not allowing the user to set the triggering actions is not obvious in light of *Lazaridis*, since *Lazaridis* only contemplates a situation where the user designates the triggers.

Second, *Lazaridis* and the claimed invention differ with respect to the selection of the data items subject to the triggering event. Again, *Lazaridis* provides for a system and method of event-driven redirection which, upon sensing a particular user-defined event has occurred, redirects *user-selected data items* from the host system to the user's device. See e.g., *Lazaridis*, column 2, lines 48-53. As discussed above, the non-skip area is not designated by the user at all. Not allowing the user to designate the non-skip area, or to select the data items, is not obvious in light of *Lazaridis*, since *Lazaridis* specifically discloses only the situation where the user selects the data items to be subject to the triggering event.

Furthermore, *Lazaridis* does not provide the explicit or implicit teaching, suggestion, or motivation to modify its disclosure, nor would one of ordinary skill in the art have recognized such considering the nature of the problem being solved and the structure disclosed. See *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). *Lazaridis* and the claimed invention relate to different problems completely and as such contain the structural differences noted above and below. On one hand, *Lazaridis* is designed to facilitate a user forwarding messages from one device, such as a personal computer, to a mobile messaging device, whereas the claimed invention allows controlled content relating to a portion of a content file to be delivered to a user. Unlike the claimed invention, the user in *Lazaridis* has full control over the content delivery and viewing. Again, the claimed invention provides a content file that

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has a non-skip area that represents an important portion of the content file that the information provider wants the user to see, where the user cannot designate the non-skip area. When the non-skip area is skipped, information corresponding to the non-skip area is transmitted to the user terminal unit using another transmission channel, such as electronic mail. Thus, the information provider is ensured that the important information has been securely delivered to the user. *See, Specification*, page 13, lines 1-5. A person having ordinary skill in the art would not recognize that the *non-user designated* non-skip area information transmission of the claimed invention is taught or suggested by the *user-defined event-driven* redirection of *user-selected* data items. In fact, the opposite is true. Thus, *Lazaridis* actually teaches away from the claimed invention.

Claims 2, 4 and 5 depend directly from independent Claims 1 and 3 and are also allowable for the reasons discussed above, and because of the additional features recited in these claims.

For at least these reasons, *Lazaridis* does not disclose, teach or suggest the claimed invention. Therefore, Applicants respectfully submit that *Lazaridis* fails to render obvious the claimed invention and thus this rejection should be withdrawn.

Claims 1 and 3 have been amended to more closely comport with the language of the specification. Specifically, the word "from" has been changed to "of." Additionally, Applicants' last amendment mistakenly left out the phrase "transmitting information indicating that the non-skip area has been skipped" from Claim 1 as it appeared in the original application. This claim language has been corrected and added back in. No new matter has been introduced with these amendments.

Claim 5 has been amended to more closely comport with the language of the specification. Specifically, "information associated with a non-skip area" has been changed to "information indicating that the non-skip area has been skipped," which is supported by the specification. *See, Specification*, page 14, lines 16-21. No new matter has been introduced with this amendment.

For the foregoing reasons, Applicants respectfully submit that the present application is in condition for allowance and earnestly solicit reconsideration of same.

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Respectfully submitted,

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